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9 UNITED STATES DISTRICT COURT
10 NORTHERN DISTRICT OF CALIFORNIA
11 OAKLAND DIVISION

13 IMPINJ, INC.,
14 Plaintiff,
15 v.
16 NXP USA, INC.,
17 Defendant.

Case No. 4:19-CV-03161-YGR

**NXP USA, INC.'S RESPONSE TO
IMPINJ'S POSITION STATEMENT
REGARDING DAMAGES PER
DKT. 509**

1 The Court asked the parties for a stipulation specifying the damages to be awarded on the
 2 '302 patent depending upon the jury's verdict in the retrial. (Dkt. 509 at 1.) The parties were
 3 able to do so, stipulating to damages through July 6, 2023 based on the original jury's award as
 4 modified by the Court's orders on the parties' post-trial motions. (Dkt. 513.)¹ But Impinj then
 5 submitted an additional "position statement" on "supplemental damages" dating from the original
 6 jury's damages award through entry of a future final judgment. (Dkt. 512-4.) As that description
 7 concedes, "supplemental" damages are different from a damages verdict, as they cover sales
 8 made after the period covered by the jury's award.

9 NXP does not dispute that if the jury affirms the validity of the '302 patent, Impinj may
 10 attempt to prove supplemental damages. But Impinj's positions here are unreasonable, and go
 11 beyond what the Court requested of the parties. Many issues relating to supplemental damages
 12 for the '302 patent are not ripe, and thus briefing supplemental damages is premature.

13 Among other things, Impinj's position as to both the rate and the base for a post-trial
 14 damages award requires consideration of evidence that was not before the jury, including
 15 supplemental sales data and new damages methodologies.² If Impinj wanted a further jury
 16 verdict on damages, it needed to ask for a damages phase of the new trial. It did not. Instead, the
 17 parties agreed that the scope of the new trial would be limited to invalidity of the '302 patent. If
 18 Impinj wishes to introduce new briefing and evidence it believes support its post-trial damages
 19 theories, it should request as much through the appropriate procedure, *i.e.*, a motion similar to the
 20 one the parties extensively briefed last October, after the jury renders a verdict on the '302 patent,

21
 22 ¹ Through that Stipulation, NXP USA and Impinj "agreed on the math" for damages
 23 associated with the '302 patent through July 6, 2023, consistent with the Court's prior Order (Dkt.
 24 471 at 16). NXP USA does not agree that it conceded the sufficiency of the evidence for lost
 25 profits for the '597 patent alone—an issue that arises only if the '302 patent is found invalid—and
 reserves all rights to appeal the Court's rulings including but not limited to whether Impinj has
 proven entitlement to lost profits for either or both patents and whether certain sales shipped to
 AdvanIDe Americas in Hong Kong are properly included in the damages base.

26 ² Impinj references in its "position statement" a letter it sent to NXP USA, proposing a
 27 new damages methodology relating to sales shipped to AdvanIDe in Hong Kong. As Impinj
 28 noted, NXP USA did respond and did reject that methodology, but Impinj neglected to attach
 NXP USA's responsive letter, in which NXP USA identified an exemplary but fatal flaw in
 Impinj's approach. For completeness, that letter is attached hereto as Exhibit 1.

1 at which point the disputed issues will be ripe.

2 Should the jury determine that the '302 patent is valid, NXP USA will respond fully to
3 Impinj's arguments in accordance with any briefing schedule set by the Court. NXP USA
4 respectfully submits that the Court should decline to entertain Impinj's supplemental damages
5 arguments at this time and in this posture.

Dated: February 2, 2024

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By: /s/ Michael C. Hendershot

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ATTESTATION PURSUANT TO CIVIL LOCAL RULE 5-1(h)(3)

In accordance with Civil Local Rule 5-1(h)(3), I attest that concurrence in the filing of this document has been obtained from the other signatory.

Executed this 2nd day of February, 2024, in Cleveland Ohio.

By: /s/ T. Kaitlin Crowder
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